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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057482
Party	Defendant Gary M. Leger and Kirk D. Dobson DBA Sequoia Wealth Management Partners
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Attachments	Answer to Petition for Cancellation (00028735).pdf(57598 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<i>In re Matter of Trademark Registration No. 3,984,290 for the trademark SEQUOIA WEALTH MANAGEMENT PARTNERS</i> Sequoia Capital Operations, LLC, Petitioner, v. Gary M. Leger and Kirk D. Dobson, Respondents.	Opposition No. 92-057482 ANSWER TO PETITION FOR CANCELLATION
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Respondents Gary M. Leger and Kirk D. Dobson, by and through their undersigned counsel, hereby respond to the Petition for Cancellation as follows:

1. Respondents are without knowledge or information regarding Petitioner's operational structure sufficient to form a belief as to paragraph 1 of the Petition for Cancellation and therefore deny the same. Respondents deny that Petitioner is an "investment firm" because the allegation is a misleading description of Petitioner's services and encroaches on the recitation of services of Respondents' mark. This encroachment is contrary to the parties' prior agreement. When Registrant applied for registration of the mark Sequoia Wealth Management Partners®, Petitioner, through John Slafsky, the same counsel of record in the Petition for Cancellation to which this Answer replies, contacted Respondents to request a Post-publication Amendment to narrow the recitation of services. Respondents narrowed their recitation of services to "financial planning and investment advisory services, excluding venture capital, private equity and hedge fund services." After Respondents amended their request for registration to services described as "financial planning and investment advisory services, excluding venture capital, private equity

and hedge fund services” as requested by the Petitioner, Petitioner agreed not to proceed with opposition to registration of the mark Sequoia Wealth Management Partners® and the registration was granted.

2. Respondents are without knowledge or information sufficient to form a belief as to paragraph 2 of the Petition for Cancellation and therefore deny the same.

3. Respondents admit the allegations in paragraph 3.

4. Respondents admit the allegation in paragraph 4 that Petitioner is the owner of the mark SEQUOIA CAPITAL, but deny the allegation in paragraph 4 that Petitioner is the owner of the mark SEQUOIA.

Respondents also deny the allegation in paragraph 4 that Petitioner’s mark is for “other investment services.” Respondents object to Petitioner’s use of this general term. The recitations of services for Petitioner’s marks specifically state: “private equity fund investment services; hedge fund investment services; real estate investment services; management of investment funds.” Petitioner and Respondents reached agreement on Respondents’ use of the mark Sequoia Wealth Management Partners® in the field of financial planning and investment advisory services prior to Petitioner’s registrations.

5. Respondents are without knowledge or information sufficient to form a belief as to paragraph 5 of the Petition for Cancellation and therefore deny the same. Respondents also deny the allegation that Petitioner has offered services under the registered mark SEQUOIA, because Petitioner does not own the registered mark SEQUOIA.

6. Respondents are without knowledge or information sufficient to form a belief as to paragraph 6 of the Petition for Cancellation and therefore deny the same.

7. Respondents are without knowledge or information sufficient to form a belief as to paragraph 7 of the Petition for Cancellation and therefore deny the same. Registrant objects to Petitioner's use of the general term "investment services." Petitioner and Registrant reached agreement on Registrant's use of the mark Sequoia Wealth Management Partners® in the field of financial planning and investment advisory services prior to the registrations of Petitioner and Respondents' marks.

8. Respondents admit the allegations in paragraph 8 in so far as the location of both Petitioner and Respondents. As to the remainder of the allegations in paragraph 8, Respondents are without knowledge or information sufficient to form a belief and therefore deny the same.

9. Respondents admit that the date of first use identified in Respondents' registration is at least as early as July 21, 2010 and deny the remaining allegations.

10. Respondents are without knowledge or information sufficient to form a belief as to paragraph 10 of the Petition for Cancellation and therefore deny the same.

11. Respondents deny the allegation contained in paragraph 11 that the mark in the Registration is likely to be confused with Petitioner's SEQUOIA CAPITAL trademarks. Further, Respondents deny Petitioner's alleged ownership of the mark SEQUOIA.

12. Respondents admit the allegations in paragraph 12 in so far as it alleges that Respondents' services are *related* to the making of investments, but deny any inference that such services include investment advisory services as are provided by Respondents. As to the remainder of the allegations in paragraph 12, Respondents are without knowledge or information sufficient to form a belief and therefore deny the same. Registrant objects to Petitioner's use of the general term "investment services." Prior to Respondents' registration, Petitioner and

Registrant reached agreement on Registrant's use of the mark Sequoia Wealth Management Partners® in the service area of financial planning and investment advisory services.

13. Respondents deny the allegation contained in paragraph 13 of the Petition for Cancellation that Respondents have not used, or have stopped using, the mark in the Registration in commerce.

14. Respondents deny the allegation contained in paragraph 14 of the Petition for Cancellation that Respondents have not used, or have stopped using, the mark in the Registration in commerce with an intent not to resume.

15. Respondents deny the allegation contained in paragraph 15 of the Petition for Cancellation that the mark in the registration has been abandoned.

16. Respondents deny the allegations contained in paragraph 16 of the Petition for Cancellation. Prior to Respondents' registration, Petitioner and Respondents reached agreement on the recitation of services to "financial planning and investment advisory services, excluding venture capital, private equity and hedge fund services." Thereafter, Petitioner agreed not to oppose registration of the mark Sequoia Wealth Management Partners®.

17. Respondents are without knowledge or information sufficient to form a belief as to paragraph 17 of the Petition for Cancellation and therefore deny the same.

AFFIRMATIVE DEFENSES

First Affirmative Defense – Failure To State A Claim

1. Petitioner has failed to allege grounds sufficient to sustain the cancellation.

Second Affirmative Defense – No Likelihood of Confusion

2. There is no evidence of actual confusion. And Petitioner's marks are not likely to be confused with Respondents' mark. Petitioner and Respondents' respective marks are

different on their face. Petitioner's mark includes the word Capital. Respondents' mark includes the words Wealth Management Services.

Additionally, as the marks make clear, the trade channels are different. Petitioner's trade includes that of capital formation through "private equity fund investment services; hedge fund investment services; real estate investment services; management of investment funds."

Respondents' trade is that of "financial planning and investment advisory services, excluding venture capital, private equity and hedge fund services."

Further, Petitioner's marks at paragraph 6 in the petition were granted after Registrant's mark, therefore inferring that the USPTO did not find any likelihood of confusion among the marks.

Finally, Petitioner's marks are not strong or entitled to a wide scope of protection.

Third Affirmative Defense – Third Party Use and Registration

3. Petitioner's alleged rights in its trademarks containing the term SEQUOIA are weakened, and the alleged likelihood of confusion with Respondents' mark is nonexistent, given the various third party uses of marks containing the term SEQUOIA or a variation thereof, including but not limited to the following valid registrations revealed on the federal registry for IC 036:

Mark	Goods	Registration/Serial Number
THE EXPERIENCE MATTERS. EXPERIENCE SEQUOIA	Real estate investment management services.	85169554
EXPERIENCE SEQUOIA	Real estate investment management services.	85168999
SEQUOIA EDGE	Property and casualty insurance underwriting services.	78938022
SEQUOIA PACIFIC BANCORP	Banking.	78888012

Fourth Affirmative Defense - Laches

4. Petitioner is barred from seeking cancellation of the Respondents' trademark under the doctrine of laches. When Registrant applied for registration of the mark Sequoia Wealth Management Partners®, Petitioner, through the same counsel of record in the Petition for Cancellation to which this Answer replies, contacted Respondents to request a Post-publication Amendment to narrow the recitation of services. Respondents amended their recitation of services to "financial planning and investment advisory services, excluding venture capital, private equity and hedge fund services," as requested by the Petitioner. Thereafter, Petitioner did not proceed with opposition to registration of the mark Sequoia Wealth Management Partners® when it had the clear opportunity to do so and its unreasonable delay in raising the opposition at this time is prejudicial to Respondents' rights.

Fifth Affirmative Defense - Estoppel

5. Petitioner is barred from seeking cancellation of the Respondents' trademark under the doctrine of estoppel. By Petitioner's request at the time of registration of Respondents' marks, the registration was modified to narrow the recitation of services. After Respondents amended their request for registration to services described as "financial planning and investment advisory services, excluding venture capital, private equity and hedge fund services" as requested by the Petitioner, Petitioner agreed not proceed with opposition to the registration of the mark Sequoia Wealth Management Partners®. Therefore, Petitioner has already received its remedy. Petitioner's assertions in the Petition for Cancellation are contrary to what its own acts (i.e., seeking and agreeing to a narrow recitation of services) and lack of action at the time of Respondents' registration (i.e., not opposing the registration) affirm.

Sixth Affirmative Defense - Acquiescence

6. Petitioner has acquiesced in registrants' adoption, registration and use of the mark that is the subject of the Petition for Cancellation. After Respondents amended their request for registration to services described as "financial planning and investment advisory services, excluding venture capital, private equity and hedge fund services" as requested by the Petitioner, Petitioner agreed not to oppose the registration of the mark Sequoia Wealth Management Partners®.

Seventh Affirmative Defense – Restriction in Registration

7. Respondents are at least entitled to their registration with the current particular restriction expressed in its recitation of services. After Respondents amended their request for registration to services described as "financial planning and investment advisory services, excluding venture capital, private equity and hedge fund services" as requested by the Petitioner, Petitioner agreed not to oppose registration of the mark Sequoia Wealth Management Partners®.

WHEREFORE, Applicant respectfully requests that the Petition for Cancellation be denied with Prejudice.

Dated: August 29, 2013

Respectfully submitted,

/Sarah McOwen/

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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 29th day of August, 2013.

/Sarah McOwen/

Sarah McOwen

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Consent Motion to Extend is being deposited as first class mail, postage prepaid, in an envelope addressed to: John Slafsky, Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, CA 94304-1050 on this 29th day of August 2013.

/Sarah McOwen/

Sarah McOwen